

REMARKS

Applicant thanks the Examiner for the attention accorded the present Application in the December 15, 2005, Office Action. Claims 1-33 are pending in this application. Reconsideration in view of the following remarks is respectfully requested.

Applicant does not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the claims in a subsequent patent application that claims priority to the instant application.

Claim Rejections

Claims 1-9 and 21-29 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Atkins et al. U.S. 6,182,212. Claims 14-16 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Schmidt et al. U.S. 2003/0074386. Claims 10-13, 30-33 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Atkins et al. in view of Goodman et al. U.S. 2003/0225927. Claims 17-20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Schmidt et al. in view of Goodman et al. Claim 17 is further objected to because of informalities.

Drawings

It is noted that the Examiner has accepted the drawings as originally filed with the application.

Informality objections

In response to the objections, claim 17 has been amended to correct a grammatical error. No new matter is therefore entered.

35 U.S.C. §102(b) rejections based on Atkins

The Examiner rejects claims 1-9 and 21-29 under 35 U.S.C. § 102(b) as allegedly being anticipated by Atkins. Applicant traverses these rejections by submitting that the Examiner has misinterpreted Atkins and, further, Atkins fails to teach or suggest each of the claim limitations.

Applicant submits that Atkins disclosure is substantially different from Applicant's claims. Specifically, Applicant claims **scanning** the computer system to identify the user system settings capable of being transferred within the computer system, **retrieving** and **storing** the user system settings capable of being transferred, and **transferring** the stored user system settings from the computer system to the storage medium (claim 1 of the present invention). "**Scanning**" of the claimed invention is directed to method of searching and determining the desirable data by means of stack structure to get the desirable program, including but not limited to Microsoft Start Menu style data structure. Applicant notes that all claims now recite "**scanning ... by utilizing a stack structure.**"

In contrast, Atkins utilizes the **data table style structure** to select and determine which files will be migrated, especially in situations where Block 52 illustrates a determination of whether or not setting migration has been selected. If not, the process merely iterates until such time as the user indicates that migration of user settings from an existing computer system to replacement computer system is desired. (col. 3, lines 18-23).

Furthermore, since Atkins discloses "**query** the system directly to **determine** the identity of the operating system" (col. 3, lines 33-34), Atkins differs from the claimed **scanning** the computer system to identify the user system settings. In addition, Atkins' Block 56 illustrates the retrieval and storing of the "Start Menu", which is inapplicable to Applicant's claimed invention.

Atkins does not teach a system, method, product or program including scanning by utilizing a stack structure.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Atkins do not disclose each and every feature of Applicant's new claims and,

therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Atkins cannot be said to anticipate any of Applicant's new claims under 35 U.S.C. § 102.

35 U.S.C. §102(e) rejections based on Schmidt

The Examiner rejects claims 14-17 under 35 U.S.C. § 102(e) as allegedly being anticipated by Schmidt. Applicant traverses the rejections by submitting that the Examiner has misinterpreted Schmidt and, further, Schmidt fails to teach or suggest each of the claim limitations.

Applicant submits that Schmidt disclosure is substantially different from claims 14-17 of the present invention. Specifically, Applicant claims that "***scanning*** the first computer system to identify the user system settings capable of being transferred within the first computer system, and "***scanning*** the second computer system to identify the user system settings matching the user system settings stored in the storage module (Applicant's claim 14). Applicant also notes that all claims now recite "***scanning ... by utilizing a stack structure.***"

In contrast, Schmidt utilizes the ***data table style structure*** to select and determine which files would be migrated, especially in paragraph 0031 and 0070-0072 cited by the Examiner.

Schmidt does not teach a system, method, product or program including scanning by utilizing a stack structure.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Schmidt does not disclose each and every feature of Applicant's amended claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. §102. Absent a specific showing of these features, Schmidt cannot be said to anticipate any of Applicant's amended claims under 35 U.S.C. §102.

35 U.S.C. §103 rejections

Claims 10-13, 30-33 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Atkins et al. in view of Goodman et al. U.S. 2003/0225927.

Claims 17-20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Schmidt et al. in view of Goodman et al.

Goodman et al. is cited as teaching a method and system for immigrating a computing environment for a source computing platform to a destination computing platform.

Goodman et al. do not teach a system, method, product or program including scanning by utilizing a stack structure.

Even if the teachings of Atkins et al., Schmidt et al., and Goodman et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: a system, method, product or program including scanning by utilizing a stack structure.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Atkins et al., Schmidt et al., or Goodman et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Atkins et al., Schmidt et al., nor Goodman et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

Applicant submits that the dependent claims 2-6, 8-13, 15-20, 22-26 and 28-33 not specifically addressed herein are allowable for the reasons discussed in

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pertinent portions associated with their independent claims 1, 7, 14, 21 and 27, as well as for their own additional features.


Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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